

REMARKS

In response to the Office Action dated October 6, 2004, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the amended claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") objected to claims 5, 15, and 16 due to informalities. The Office rejected claims 1-5 and 13-18 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,675,384 to Block *et al.* Claims 6-8 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block*. Claims 10-12 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block* in view of U.S. Patent 5,774,170 to Hite. Claims 9 and 19 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block* in view of U.S. Patent 5,973,683 to Cragun. The Assignee shows, however, that the pending claims are not obviated by any combination of *Block* and *Cragun*. The Assignee thus respectfully submits that the pending claims are ready for allowance.

Objection to Claims

The Office objected to claims 5, 15, and 16 due to informalities. These claims, however, have been canceled, so the rejection is moot.

Rejection of Claims under 35 U.S.C. § 102 (e)

The Office rejected claims 1-5 and 13-18 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,675,384 to Block *et al.* These claims, however, have been canceled, so the rejection is moot.

Rejection of Claims 6-8

Claims 6-8 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Claims 6-8 are not obvious in view of *Block*. Claim 6 “distribut[es] alternate scenes for use in the program, ... *the alternate scenes selected by viewers*” (emphasis added). The patent to *Block*, however, fails to mention viewer selection of alternate scenes. Examiner Brown even admits that *Block* is silent to viewer selection of alternate scenes. Examiner Brown, however, rejects claim 6 by attempting to take “Official Notice” that scene selection of alternate scenes was known in the art. Even if this “Official Notice” is true, Examiner Brown fails to assert that viewer selection of alternate scenes, as claim 6 recites, was known in the art. The patent to *Block* fails to realize that viewers themselves may select alternate scenes. No where does *Block* mention or suggest that the viewer may select alternate scenes. Thus, despite “Official Notice,” the *prima facie* case for obviousness must fail. Because the patent to *Block* fails to describe “*alternate scenes selected by viewers*,” and because the Examiner fails to assert “Official Notice” that “viewer selection” of alternate scenes was known in the art, claim 6 cannot be obvious in view of *Block*. The patent to *Block* cannot support the *prima facie* case for obviousness, so Examiner Brown is required to remove the rejection.

Rejection of Claims 10-12

Claims 10-12 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block* in view of U.S. Patent 5,774,170 to Hite. These claims, however, have been canceled, so the rejection is moot.

Rejection of Claims 9 & 19

Claims 9 and 19 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block* in view of U.S. Patent 5,973,683 to Cragun. The Assignee shows, however, that the attempted combination of *Block* and *Cragun* fails to teach or suggest all the claimed features. The Assignee also shows that the proposed combination of *Block* and *Cragun* “teaches away” and cannot support a *prima facie* case for obviousness. Moreover, Examiner Brown has failed to properly present a *prima facie* case for obviousness. The Assignee thus respectfully requests that Examiner Brown remove the § 103 (a) rejection and allow claims 9 and 19.

1. The Combination of *Block* and *Cragun* “Teaches Away” and Does Not Support A *Prima Facie* Case

The proposed combination of *Block* and *Cragun* “teaches away” from claims 9 and 19. “A prior art reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A prior art reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The proposed combination of *Block* and *Cragun* changes *Block*’s principal of operation. The Examiner attempts to combine *Block* with the electronic information based television guide of *Cragun*. These two prior art references, however, have very different principals of operation, so the proposed combination cannot support a *prima facie* case of obviousness. The patent to *Block*, in short, transmits ratings labels as part of a video signal or as part of an out-of band channel. The patent to *Cragun*, however, locally downloads an electronic television guide to a user’s computer. *Block*, then, would have to have its principle of operation impermissibly changed to download electronic programming guides as described by *Cragun*. Because the

proposed combination impermissibly changes *Block*'s principle of operation, the teachings of the references are not sufficient to support a *prima facie* case. Examiner Brown is thus required to remove the rejection.

Block explains his principle of operation. *Block* combines programming signals with synchronizing signals. See U.S. Patent 6,675,384 to Block (Jan. 6, 2004) at Abstract, lines 2-5. See also *id.* at column 3, lines 43-46; column 3, lines 59-60; and FIGS. 1-4. A "transmitted information label" (referred to as "TIL") is transmitted with programming signals. *Id.* at column 4, lines 46-50. The TIL is "used to identify and characterize the content of the audio and video program signals." *Id.* at column 4, lines 50-52. The TIL may be transmitted "in band" or "out of band." *Id.* at column 5, lines 13-17. The TIL may contain many different types of information, including instantaneous ratings information. See, e.g., U.S. Patent 6,675,384 to Block (Jan. 6, 2004) at column 5, lines 37-39; see also *id.* at Table 1 and at Table 2. The TIL is then transmitted to "viewer station equipment," and the TIL includes coded processing instructions. *Id.* at column 8, lines 48-53. These coded processing instructions "instruct the viewer station equipment as to how to process the incoming signals." *Id.* at column 8, lines 51-53. *Block*, then, transmits the TIL with programming signals, and the TIL may include coded ratings information. The TIL also instructs the viewer's equipment to process the coded information.

Cragun, in contradistinction, downloads electronic programming guides. *Cragun* does not transmit ratings information combined with programming signals, as *Block* provides. As *Cragun* explains, "an object of the present invention [is] to provide a method and system for *down loading* television ratings and television scheduling *from user selected sources*." U.S. Patent 5,973,683 to Cragun (Oct. 26, 1999) at column 5, lines 59-63 (emphasis added). "The Internet is used in the present invention for searching and finding acceptable sources of ratings then ... 'downloading' the data into [a] computer system." *Id.* at column 9, lines 26-31. "The present invention allows a parent to select from a wide variety of ratings *rather than being fettered by ratings which originate from the broadcasters*." *Id.* at column 9, lines 43-46 (emphasis added). "The present invention receives parent or user selected ratings sources via the Internet using [a] computer system." *Id.* at column 9, lines 47-49. "Thereafter, [the] computer

system controls [a] receiver such that television programs are displayed based on a parent's criteria as opposed to a broadcaster's criteria." U.S. Patent 5,973,683 to Cragun (Oct. 26, 1999) at column 9, lines 49-52. "Therefore, a television censoring and feedback schedule can be downloaded from chosen ratings providers." *Id.* at column 10, lines 14-17.

Block and *Cragun*, then, have different principles of operation. *Block* combines programming signals with a "transmitted information label." The TIL may contain instantaneous ratings information. *Cragun*, on the other hand, does NOT combine electronic programming guides with programming signals, as *Block* instructs. *Cragun*, instead, downloads electronic programming guides to a computer. If *Block* and *Cragun* were combined, as the Office proposes, *Block* would have to have his principle of operation impermissibly changed to download electronic programming guides. Because the proposed combination impermissibly changes *Block's* principle of operation, the teachings of the references are not sufficient to support a *prima facie* case. Examiner Brown is thus required to remove the rejection.

When *Block* and *Cragun* are considered as whole, the combination of *Block* and *Cragun* does not teach the features recited in claims 9 and 19. Because the proposed combination of *Block* and *Cragun* teaches away and changes the principle of operation of a reference, the combined references cannot support a *prima facie* case. The Assignee, then, respectfully asks Examiner Brown to remove the rejection.

2. The *Prima Facie* Case of Obviousness Must Fail for Failing to Teach All Claim Elements

The proposed combination of *Block* and *Cragun* fails to teach or suggest all the features of claims 9 and 19. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL

OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). Here, however, the proposed combination of *Block* and *Cragun* fails to teach or suggest all the features of claims 9 and 19, so the *prima facie* case for obviousness must fail.

Claims 9 and 19 are not obvious in view of *Block* and *Cragun*. Both claims 9 and 19 embed program data in a channel carrying an Electronic Programming Guide. Claim 9 is reproduced below:

9. A method for formulating and delivering data for use in controlling the presentation of a program and portions thereof, the method comprising:

formulating frames of program data and associating each frame with a discrete portion of the program, wherein the program data comprises (1) content data, (2) control data, or (3) both content and control data;

delivering the program data to a transmission facility;

distributing the program data to viewers by embedding the program data in a channel carrying an Electronic Programming Guide.

Claim 19 includes a similar feature. The proposed combination of *Block* and *Cragun*, as explained above, does not teach or suggest this feature. *Block* combines programming signals with a “transmitted information label” (or “TIL”), and this TIL may contain instantaneous ratings information. *Cragun*, on the other hand, downloads electronic programming guides to a computer. *Cragun* does not embed program data “*in a channel carrying an Electronic Programming Guide*,” as claims 9 and 19 recite. The proposed combination of *Block* and *Cragun*, therefore, fails to teach or suggest all the features recited in claims 9 and 19, so the *prima facie* case for obviousness must fail. Examiner Brown is thus required to remove the rejection.

3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Teaching, Suggestion, or Motivation

The Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). **When the motivation to combine the teachings is not apparent, the Examiner has a duty to explain why the combination is proper.** See *id.* at 2142; see also *In re Skinner*, 2 U.S.P.Q.2d (BNA) 1788 (Bd. Pat. App. & Inter. 1986) (emphasis added). **Even if the references teach all aspects of the claimed invention, the Examiner's *prima facie* case must still include some objective reason to combine the references.** See M.P.E.P. at § 2143.01; see also *In re Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).

Here, the office action fails to identify any teaching, suggestion, or motivation to combine the cited references. The Examiner makes no effort to explain why the combination is proper. The Assignee, in fact, has already shown that *Block* has a very different principle of operation from that of *Cragun*. One of ordinary skill in the art, then, would not be motivated to combine references having such diverse principles of operation. Regardless, because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

4. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success

The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE,

MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here, the office action fails to identify any expectation of success. The Examiner makes no effort to explain why one of ordinary skill in the art would expect success when attempting to combine *Block* and *Cragun*. Because *Block* and *Cragun* have very different principles of operation, one of ordinary skill in the art would not expect success to attempt the proposed combination. Regardless, because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Excess Claim Fees

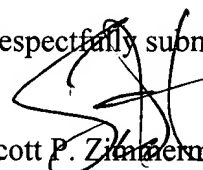
This response includes an excess claim fee of \$850. New claims 20-24 require an excess claim fee of \$250 (\$50 x 5). Because the application was originally filed with only two (2) independent claims, only three (3) new independent claims require payment. The excess claim fee for new independent claims 6, 9, and 19 is \$ 600 (3 x \$200). The total excess claim fee is thus \$850. The Assignee herewith includes a check for \$850 for the excess claim fee.

The patent to *Block*, whether considered alone or in combination with *Cragun*, fails to obviate the pending claims. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection. Because the pending claims are patentably distinguishable over and combination of *Block* and *Cragun*, the Assignee respectfully requests that a Notice of Allowability issue.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

U.S. Application No. 09/751,809 Examiner Brown, Art Unit 2611
Response to First Office Action

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", written over the printed name.

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